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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/971,878

Applicant(s)

LE ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/1/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This is in response to request for continued examination dated June 1, 2004.

Amendments to claims 1-5, 7 and 9, cancellation of claims 10-15 and addition of new claims 16-34 have been entered. Claims 1-9 and 16-34 are pending in the application and have been examined. The objections to specification, rejections and response to arguments are stated below.

Specification

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1-9 and 16-34 include the limitation "customs invoice information, which is additional information on documents typically in transit with purchased goods". However, the specification does not provide an enabling disclosure to support the claimed limitation of "customs invoice information, which is additional information on documents typically in transit with purchased goods". Also the specification does not provide an enabling disclosure to support the claimed limitations of "the customs invoice information includes information generated

based on customs requirements of the country for which the brokering party is brokering the goods” in claim 16; “the customs invoice information includes a description of goods consistent with requirements of the country for which the brokering party is brokering the goods” in claim 17; “the customs invoice information includes a description of goods consistent with best practices of the country for which the brokering party is brokering the goods” in claim 18; “the customs invoice information includes a classification of goods consistent with requirements of the country for which the brokering party is brokering the goods” in claim 19; “the customs invoice information includes a classification of goods consistent with best practices of the country for which the brokering party is brokering the goods” in claim 20; “the customs invoice information is generated to be consistent with prior shipments of the seller” in claim 21; “the customs invoice information is generated to be consistent with prior shipments of the buyer” in claim 22; “the customs invoice information is generated based upon the country for which the brokering party is brokering the goods” in claim 23; “the customs invoice information pertains to preferred business practices of customs submission in the country for which the brokering party is brokering the goods” in claim 24; “the customs invoice information includes information based upon prior transactions by the seller” in claim 25; “wherein the customs invoice information includes information based upon prior transactions by the buyer” in claim 26; “wherein in the step of generating customs instructions, the customs invoice information includes information specifying duties to be paid” in claim 27; “wherein the duty-payment information includes information regarding an assist” in claim 28; “the customs invoice information is transmitted such that the brokering party receives the customs invoice information separately from documents accompanying the goods” in claim 30; “customs invoice information,

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which is additional to information on documents typically in transit with purchased goods, for a second country that is different than the first country and further comprising: transmitting the customs invoice information for the second country to a brokering party for the second country” in claim 32; and “wherein the brokering party for the first country is different from the brokering party for the second country” in claim 33.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-9 and 16-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1-9 and 16-34 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.
6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
7. Claim 1-9 and 16-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For claim 1, the limitation “receiving authorization to conduct the transaction” is vague and unclear. It is not clear if the authorization is received from the buyer, seller, one of the modules or some third party. Clarification is required. Claims 2-5 and 16-34 are rejected because they are dependent on a rejected claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 17, 29, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1).

With reference to claims 1 and 34, Pool teaches a method and system of conducting an international transaction in goods between a buyer and a seller of the goods, the method comprising: identifying a source country from which the seller will ship the goods and a destination country to which the goods will be shipped (See Pool Column 7 lines 28-30 and Column 8 lines 8-10); querying a shipping module to calculate a total shipping cost for shipping the goods along a shipping rout from the source country to the destination country (See Pool Column 7 lines 28-34); querying a brokering module to calculate a total brokering, cost for brokering the goods along the shipping rout (See Pool Column 11 lines 61-66 and Column 12 lines 55-58); querying a tax module to calculate a total tax cost for the sale and transportation of the goods (See Pool Column 7 lines 28-34); providing a total cost to the buyer, the total cost including a sale price, the total shipping cost, the total brokering cost and the total tax cost (See Pool Column 8 lines 45-50 and Column 12 lines 56-58); receiving authorization to conduct the transaction (See Pool Column 3 lines 49-51); transmitting shipping instructions to a carrier (See Pool Column 11 lines 53-60); generating customs invoice information for a first country (See Pool Column 11 line 67 – Column 12 line 17); and transmitting customs invoice information to a

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brokering party for the first country (See Pool Column 11 lines 59-65). The step of querying and the step of calculating the total brokering cost are inherent in the disclosure of Pool. The customs invoice includes copies of commercial invoice, bill of lading and export packing list and the commercial entity that specializes in moving these papers from the carrier to the customs department is the brokering party. Using modules in a computer system is old and well known. These modules help in responding to queries speedily and efficiently.

With reference to claim 2, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the step of automatedly transmitting manufacture instructions upon receiving authorization to conduct the transaction.

Official notice is taken that the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction is old and well known in the art. This is especially common for custom-made goods and for products that are ordered in large quantities (larger than the conventional inventory carried by the manufacturer). Such instructions help the buyer get the products made to their specification and help the manufacturer save on inventory costs.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would have helped the buyer get the products made to their specification and it would have helped the manufacturer save on inventory costs.

With reference to claim 3, Pool discloses a method of claim 1 wherein the step of transmitting the shipping instructions includes transmitting the total shipping cost calculated in

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the step of querying a shipping module to the carrier (See Pool Column 7 lines 28-34, Column 12 lines 4-7 and Column 12 lines 17-22). The step of arranging for funds to the international carrier includes the transmission of total shipping cost. When using carriers like FedEx and UPS the shipping costs are normally paid up front.

With reference to claim 4, Pool discloses a method of claim 1 wherein the step of transmitting a customs invoice information includes transmitting the total brokering cost calculated in the step of querying a brokering module to the broker (See Pool Column 7 lines 5-10 and Column 12 lines 17-22). The forwarding charges are interpreted to include the total brokering cost and some other agent is interpreted to include the broker.

With reference to claim 5, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the steps of automatedly receiving and tracking status updates regarding the status of the goods in transit and providing status reports summarizing the received status updates in response to status requests from the buyer.

Official notice is taken that the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in summary form in response to status requests from the buyer are old and well known in the art. These steps help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in summary form in response to status requests from the buyer to the disclosure of Pool. The combination of the disclosures taken as a whole suggests

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that it would help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

With reference to claim 6, Pool discloses a method of claim 1 wherein the authorization to conduct the transaction is received from the buyer after the step of providing a total cost to the buyer (See Pool Column 3 lines 46-51).

With reference to claims 17, 29 and 31, Pool discloses a method of claim 1 wherein the customs invoice information includes a description of goods consistent with requirements of the country for which the brokering party is brokering the goods (See Pool Column 11 lines 14-26); the customs invoice information is transmitted such that the concerned party receives the customs invoice information prior to the arrival of the goods in customs of the country (See Pool Column 11 line 67 – Column 12 line 17); and wherein the first country is the destination country (See Pool Column 14 lines 19-65)

10. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1) in view of Dutta et al (US Patent 2003/0061058 A1).

With reference to claims 7-9, Pool teaches a method of claim 6 as discussed above including the step of transmitting messages to relevant legal compliance modules configured to track legal compliance information for subsequent reporting to relevant national governments (See Pool Column 10 lines 25-33)

Pool does not explicitly teach the steps of querying to identify any national restrictions that would make the transaction illegal and notifying concerned parties if the transaction is identified as illegal, transmitting an authorization to bill to a billing module upon receipt of a proof of delivery and automatically repeating the steps of querying and notifying.

Dutta discloses the steps of querying to identify any national restrictions that would make the transaction illegal (See Dutta Page 2 Paragraph 22). Official notice is taken that the steps of notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery are old and well known in the art. Notifying all parties if the transaction is identified as illegal provides a reason to the buyer as to why the transaction cannot be completed and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised. Automatedly repeating the process of querying and notifying is old and well known in the art. This automation provides alerts without having to manually monitor and also saves time compared to a manual process.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of querying to identify any national restrictions that would make the transaction illegal and notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would help all concerned parties avoid illegal transactions and provide a reason to the buyer as to why the transaction cannot be completed. Transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised.

Response to Arguments

11. Applicants' arguments with respect to claims 1-9 have been considered but are moot in view of objections to specification and the new ground(s) of rejection.


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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
September 16, 2004

 9/16/04
Jagdish N. Patel
Primary Examiner